

REMARKS

Claims 1 through 21 are pending in this Application, of which claims 13 through 21 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 through 12 are active.

Fig. 22 has been amended by providing a lead line for element 111b, consistent with page 2 of the written description of the specification, line 14. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon JP Publication No. 10/229180 (Kuroiwa)¹ in view of DiLoreto et al.

In the statement of the rejection the Examiner asserted that Kuroiwa discloses a solid state imaging device comprising, *inter alia*, microlens 24 (Fig. 2) inaccurately characterized as an optical lens, image sensor 16, 17 and microlens 22. The Examiner interpreted microlens 22 as having two layers of the same refractive index (film 22 and film 21 of SiN). The Examiner **admitted** that Kuroiwa does not disclose a resin layer between the lens 24 and lens 22, but identified image filter 19. The Examiner concluded that one having ordinary skill in the art would have been motivated to employ the filter disclosed by DiLoreto et al. in Kuroiwa's device, asserting that the filter disclosed by DiLoreto in Figs. 4 through 6 comprises a resin film 62. This rejection is traversed.

Applicants submit that the Examiner's rejection is predicated upon an inaccurate determination as to the teachings of Kuroiwa's disclosure. Specifically, the Examiner asserted that Kuroiwa discloses a device in Fig. 2 comprising an optical lens 24. This determination is **not factually accurate**, because the element denoted by reference character 24 in Fig. 2 of Kuroiwa is

¹ The Examiner referred to this reference by the inventor's first name Atsushi, rather than the last name Kuroiwa. Applicants will refer to this reference by the inventor's last name of Kuroiwa.

not, repeat **not**, an optical lens. The element in Fig. 2 of Kuroiwa denoted by reference character 24 is a **microlens**. A microlens is **not** an optical lens.

Adverting to Fig. 2 of the present Application and the related disclosure thereof in the written description of the specification, it should be apparent that an optical lens and microlens are different and are defined differently. An optical lens is defined as a lens having a function that condenses reflected light from an object and provides the condensed light with a solid state image device from the outside. On the other hand, a microlens is defined as a lens having a function that condenses light **inside** the solid state image device. Applicants, of course, are entitled to be their own lexicographer. *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 39 USPQ2d 1573 (Fed. Cir. 1996). Certainly, one having ordinary skill in the art would have interpreted the claimed invention in light of and consistent with the written description of the specification, as judicially required, thereby recognizing the above argued distinction between the microlens of the device defined in claim 1 and the optical lens defined in claim 1. *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 59 USPQ2d 1489 (F.C. 2001); *In re Cortright*, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999); *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

Based upon the above definitions and proper interpretation of the device defined in independent claim 1, it should be apparent that the lens indicated by reference character 24 in Fig. 2 of Kuroiwa is **not**, repeat **not**, an optical lens. Rather, element denoted by reference character 22 in Fig. 2 of Kuroiwa is a **microlens**. A microlens is **not** an optical lens. Further evidence is the **fact** that reference character 24 is referred to as a “**microlens**” in the **abstract of Kuroiwa**. Thus, the Examiner’s reliance upon and application of Kuroiwa is based upon an inaccurate factual determination as to the teachings of Kuroiwa.

The above argued defect in Kuroiwa is not cured by the secondary reference to DiLoreto et al., which the Examiner has relied upon merely for the disclosure of a resin. Therefore, even if DiLoreto and Kuroiwa are combined as suggested by the Examiner, and Applicants do **not** agree that the requisite fact-based motivation has been established, the claimed invention would **not** result, because the resulting structure would **not** have any optical lens as in the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Based upon the foregoing Applicants submit that the imposed rejection of claims 1 through 9 under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 10 and 11 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al. and Needham.

Claim 12 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al., Needham and Wolf.

Each of the above rejections of claims 10 and 11 and of claim 12 under 35 U.S.C. § 103 is traversed. Specifically, claims 10 through 12 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al. The additional references to Needham and Wolf do not cure the previously argued deficiencies in the attempted combination of Kuroiwa and DiLoreto et al. which does not result in a device having an optical lens. Accordingly, even if all of the references are combined as suggested by the Examiner, and again Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

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Applicants, therefore, submit that the imposed rejection of claims 10 and 11 under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al. and Needham, and the imposed rejection of claim 12 under 35 U.S.C. § 103 for obviousness predicated upon Kuroiwa in view of DiLoreto et al., Needham and Wolf, are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached replacement sheet of drawing (Exhibit A) includes a change in Fig. 22 which merely provides a lead line for reference character 111b. This replacement sheet replaces the original drawing sheet for Fig. 22.